

### REMARKS

Claims 1-26 are pending in this application. Claims 1, 4, 5, 12, 15, 16, 17, 20 and 21 been amended to define Applicant's invention still more clearly. Claims 22-26 have been added to assure Applicant of a full measure of protection. Claims 1, 6, 11, 12 and 22 are in independent form.

Applicant notes with appreciation the allowance of Claims 6-11.

Claim 4 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. That claim has been reviewed and amended as deemed necessary to ensure that it complies with the requirements of Section 112, and the withdrawal of the rejection under that Section is respectfully requested.

Claims 1-4, 12-15 and 17-20 were rejected under 35 U.S.C. § 103(a) as being obvious from U.S. Patent 6,104,498 (Shima et al.), and Claims 5, 16 and 21, as being obvious from that patent in view of U.S. Patent 5,237,923 (Williams et al.).

As is described in more detail in the specification, the present invention is concerned with improvement of systems in which the use of a test print function may have the disadvantage of rendering temporarily unavailable the re-setting of job parameters for a print job, or of causing a print job that has been spooled to be executed in a way other than what the user wishes.

Independent Claim 1 is directed to a print control method for controlling a printing apparatus to print, in which a print command issued from an application is converted into intermediate data, which is saved in a storage unit together with the designated number of copies. A discrimination is made as to whether a print instruction is

a test print instruction, and if so, data is generated for test print for which the number of copies to be printed is set to one in accordance with the intermediate data saved in the saving step. The data for test print generated in the generating step is output to the printing apparatus instruction, and data is re-generated for printing based on the intermediate data saved in the saving step in accordance with an operating instruction after the data for test print is output.

Among other important features of the method of Claim 1 is that data for test print and print data to be printed after the test print is generated using a print command converted and saved in a storage unit, for example, a hard disk in a host computer, before the test print. Thus, according to this method, the intermediate data generated for the test print can be effectively utilized. After the test print for a document is performed, the document can be printed without generating the intermediate data of the document. Moreover, a test print can be performed using a printer which does not have a test print function and memory capacity sufficient to store all pages of the document to be printed.

*Shima* relates to a printer that examines specifications of print data from a computer and determines a procedure of printing according to the specifications. The printer receives print information data from the host computer, converts the print information into intermediate print information, and stores the latter. The intermediate information is utilized in printing the received print information according to the print specification. For example, if face-down printing is specified for a print job, the intermediate print information generated from the job is converted into a bitmap image in

the received order of print information even if the completion of the print job is not informed.

Applicant submits, however, that nothing has been found in *Shima* that would teach, or even hint at, the recited “re-generating step”, of re-generating data for printing based on intermediate data saved in accordance with an operating instruction after the data for a test print is output. In addition, because development of the print information is performed by the printer, memory capacity sufficient to generate and save the developed intermediate information must be provided to the printer. The printer cannot complete printing all pages of the job otherwise.

For these reasons, Claim 1 is deemed clearly allowable over *Shima*.

*Williams* relates to a printing apparatus with a lithographic plate. The apparatus performs proof print of an original copy. Applicant notes, however, that nothing in *Williams* would teach or suggest that the number of copies is set to one when a test print is designated, and nor does that patent teach or suggest the recited “re-generating step”, of re-generating data for printing based on the intermediate data saved in accordance with an operating instruction after the data for test print is output. Claim 1, therefore, is also deemed to be clearly allowable over *Williams* taken alone.

As described, because neither *Shima* nor *Williams* teaches or suggests the recited re-generating step, the document cannot be printed without generating the intermediated data of the document using either patent, and even if the two are combined (and assuming that such a combination would even be permissible), the result of the combination would not avoid this disadvantage, and would not have or suggest the recited .

re-generating step. Moreover, a test print cannot be performed using a printer which does not have a test print function and memory capacity sufficient to store all pages of the document to be printed, and it is not seen how the proposed combination would provide a printer having such capacity.

For these reasons, it is believed to be clear that Claim 1 is allowable over *Shima* and *Williams*, taken separately or in any permissible combination (if any).

Each of the other independent claims not yet allowed is believed to be allowable over *Shima* and *Williams* for at least the reasons discussed above with regard to Claim 1.

The other claims not yet allowed in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual consideration or reconsideration, as the case may be, of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

Applicant's undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

A handwritten signature in cursive script, reading "Leonard P. Diana", written over a horizontal line.

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